

Remarks

Claims 1 and 3-21 are pending after entry of the foregoing amendment.

Claims 2 and 22 have been canceled. Claims 1, 18, and 20 have been amended to more clearly define applicant's invention. In particular, the claims have been amended to specify that the inner surface of the top wall and the inner surface of the bottom wall define *a single* fluid tight cavity and that the two or more baffles *impede* the flow of the thermal fluid *within* this single cavity. Support for this amendment is found in original claim 2 and throughout the specification, particularly at page 5, lines 4-14 and 26-28; and FIGS. 1-3.

Rejections Under 35 U.S.C. § 102

Claims 1-6, 8-10, 12-16, 18, and 19 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,409,500 to Dyrek (hereinafter "Dyrek"). The rejection is respectfully traversed, if applied to the claims as amended.

Applicant's claimed thermal pack for the breast is novel over Dyrek. Applicant's thermal pack includes a plurality of baffles that impede the flow of the thermal fluid within the pack's single cavity. In contrast, Dyrek discloses a cold pack having a plurality of *discrete compartments*. Dyrek fails to expressly or inherently disclose a pack having baffles.

The Office Action mischaracterizes the flexible seals 118 of the Dyrek pack as baffles. These seals are not baffles. They do not function as a baffle. Dyrek discloses that these flexible seals serve to *separate discrete compartments* (Col. 8, Lines 11-23 and FIGS. 13-15). One skilled in the art simply would not equate a "sealing edge" to a "baffle." Rather, the seals define the outer perimeter of the cavity. Furthermore, the flexible seals of Dyrek clearly are not functionally equivalent to the baffles of applicant's breast pack because they do not *impede*

(e.g., slow or control) the flow of fluid *within a single cavity*. There simply is no structure within the cavities of Dyrek's cold pack that impede or otherwise control the flow of fluid within the cavities of Dyrek's cold pack.

Moreover, the Dyrek cold pack is made for application to the *knee or elbow* (Col. 8, Lines 25-28; FIGS. 13-16). It is not disclosed to be suitable or adaptable for the *breast*.

For all of the foregoing reasons, applicant's claims as amended are clearly novel over Dyrek.

Rejections Under 35 U.S.C. § 103

Claim 7 was rejected under 35 U.S.C. § 103 as obvious over Dyrek in view of U.S. Patent No. 6,083,254 to Evans (hereinafter "Evans"). Claim 11 was rejected under 35 U.S.C. § 103 as obvious over Dyrek. Claims 17 and 20-22 were rejected under 35 U.S.C. § 103 as obvious over Dyrek in view of U.S. Patent No. 5,050,595 to Krafft (hereinafter "Krafft"). The rejections are respectfully traversed, if applied to the claims as amended.

Claims for an invention are not *prima facie* obvious if the primary references do not suggest all elements of the claimed invention and the prior art does not suggest the modifications that would bring the primary references into conformity with the application claims. In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992); In re Laskowski, 871 F.2d 115 (Fed. Cir. 1989). The Office Action does not set forth a *prima facie* case of obviousness with respect to the claims as amended.

Nothing in Dyrek or Evans suggests all of the limitations of the claims as amended, as neither reference suggests a thermal pack for the breast. In particular, nothing in these references, alone or in combination, would have led one of ordinary skill in the art to modify the

Dyrek device to derive a breast pack wherein the inner surface of the top wall and the inner surface of the bottom wall define *a single* fluid tight cavity and which has two or more baffles that *impede* the flow of the thermal fluid *within* this single cavity. “Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” ATD Corp. V. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998). Only in hindsight of Applicant’s disclosure would one of ordinary skill in the art be led to somehow combine and extend the disclosure of Dyrek, alone or in combination with Evans, to somehow derive the presently claimed devices.

Furthermore, with respect to claims 17 and 20-22, there is motivation to combine Dyrek with Krafft. The CAFC has warned that “the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for showing of the teaching or motivation to combine prior art references.” In re Dembiczak, 175 F.3d 994 at 999 (Fed. Cir. 1999). While the suggestion to combine may be found in explicit or implicit teachings within the references, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved, the “question is whether there is something in the prior art *as a whole* to suggest the desirability, and thus the obviousness, of making the combination. WMS Gaming, Inc. v. International Game Technology, 184 F.3d 1339 at 1355 (Fed. Cir. 1999). “The range of sources available, however, does not diminish the requirement for **actual evidence**. That is, the showing must be **clear and particular**.” In re Dembiczak, 175 F.3d 994 at 999 (Fed. Cir. 1999) (emphasis added).

The Office Action does not provide the required clear and particular showing that the prior art as a whole suggests the desirability, and thus the obviousness, of making the claimed

combination of elements. Rather, the Office Action's rationale is conclusory, indicating that it would be obvious to combine the art to achieve the benefits taught and claimed by the applicant.

Nothing in the references suggests a problem to be solved, which would lead one of ordinary skill in the art to look to the other reference. That in hindsight of applicants' disclosure a skilled artisan arguably may be able to recognize, cull, modify, and combine certain claim elements from disparate references is not evidence of a clear and particular motivation to combine those references. *See, e.g., In re Lee*, 61 U.S.P.Q.2d 1430, 1433-34 (Fed. Cir. 2002).

Nevertheless, even if Krafft and Dyrek are combined, their teachings still do not provide the required motivation or teaching to one of ordinary skill in the art to derive the claimed breast pack having a plurality of baffles that impede the flow of the thermal fluid within the pack's single cavity. "Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. V. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). Only in hindsight of Applicants' disclosure would one of ordinary skill in the art be led to somehow combine and extend the disclosures of Krafft and Dyrek to somehow derive the presently claimed packs, kits, and methods. The prior art, as a whole, fails to suggest the claimed combination of elements defined by applicants' claims, and no "particular finding" support a *prima facie* case of obviousness.

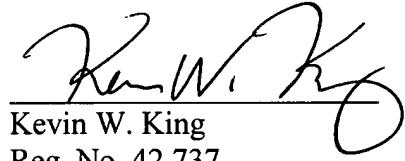
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AMENDMENT &
RESPONSE TO OFFICE ACTION

Conclusions

For the foregoing reasons, applicant submits that the claims are novel and nonobvious over the prior art of record. Allowance of claims 1 and 3-21 is therefore respectfully solicited.

The undersigned respectfully invites the Examiner to contact him by telephone (404.853.8068) if any outstanding issues can be resolved by conference or examiner's amendment.

Respectfully submitted,



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